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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,698	06/30/2003	Hemingway Huynh	111255-135502	4440

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EXAMINER
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WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/611,698

Applicant(s)

HUYNH ET AL.

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 34 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 34 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the amendment filed February 27, 2007.
2. Claims 1-10, 34, and 40-43 have been examined and are pending with this action.
3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

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the required "Sequence Listing" is not submitted as an electronic document on compact disc).

(Note: Summary missing)

***Response to Amendment***

4. The declaration filed on February 27, 2007 under 37 CFR 1.131 is sufficient to overcome the Parolkar et al. (US 6,704,396 B2) reference.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 6, and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no explicit teaching in the specification of "a media message including a **first reference**" (emphasis added).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1, 6, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. The examiner cannot determine the functional limitation of "first reference is given effect". Although the specification states "inclusion link 212 is **given effect** in order to incorporate the testing and selecting" (see page 8, lines 4-6: emphasis added), there is no other recitation or example of what functionality this **given effect** encompasses.

7. Claims 1, 6, and 34 recite the limitation "**first** reference" (emphasis added). There is insufficient **numerical** antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 23, 34, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai et al. (US 6,594,699 B1) in view of Hill et al. (US 6,023, 714 A).

#### **INDEPENDENT:**

As per **claim 1**, Sahai teaches an article comprising:

a storage medium (see col.8, line 37: "stored on the server"); and

instructions stored in the storage medium, which, when executed by a processor (see col.2, line 47: "server computer/processor 10" and col.8, lines 48-50: "computer program executing on said server"), cause the processor to generate and transmit one

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or more messages to a receiving computer system (see col.2, lines 61-64: "responds to the transfer request by streaming the data over the network to the client"), the one or more messages including:

logic for testing digital content capabilities of the receiving computer system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities... are then determined"); and

logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be used for playback of multimedia streams based on the client machine capabilities"), such that the receiving computer system may use the media message to display the selected version of the digital content (see col.5, lines 45-46: "media player plays 38 the data as it is received to the user of the client 12").

Although Sahai teaches of a media message (see col.2, lines 59-60: "multimedia data") and logic for testing the digital content capabilities of the receiving computer system (see above), Sahai does not explicitly teach of including a first reference and testing when the first reference is given effect.

Hill teaches of a first reference and testing when the first reference is given effect (see col.10, lines 17-26: "The layout generator is executed by the client... interrogates the output device to determine the capabilities of the output device").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Hill to implement a first

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reference and testing when the first reference is given effect. One would be motivated to do so because Sahai teaches that alternatively a server can send or stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

As per **claim 6**, Sahai teaches a method in a computing system for presenting an adaptive message (see col.5, lines 41-45: "formatting the data and adapting it"), comprising:

receiving a message in the computing system (see col.5, lines 41-45: "steams 36 the data to the of the client 12");

based on the contents of the received message: testing, two or more digital content capabilities (see col.3, lines 25-60) of the computing system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities... are then determined"); selecting one of a plurality of different digital content elements based upon the results of the testing (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be used for playback of multimedia streams based on the client machine capabilities"); and presenting the selected one of the plurality of different digital content elements within the message (see col.5, lines 45-46: "media player plays 38 the data as it is received to the user of the client 12").

Sahai does not explicitly teach of message including a first reference and testing when the first reference is given effect.

Hill teaches of a first reference and testing when the first reference is given effect (see col.10, lines 17-26: "The layout generator is executed by the client... interrogates the output device to determine the capabilities of the output device").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Hill to implement a first reference and testing when the first reference is given effect. One would be motivated to do so because Sahai teaches that alternatively a server can send or stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

As per **claim 34**, Sahai teaches an article comprising:

a storage medium (see col.8, line 37: "stored on the server"); and

instructions stored in the storage medium, which, when executed by a processor (see col.2, line 47: "server computer/processor 10" and col.8, lines 48-50: "computer program executing on said server"), cause the processor to generate and transmit one or more messages to a receiving computer system (see col.2, lines 61-64: "responds to the transfer request by streaming the data over the network to the client"), the one or more messages including:

logic for testing capabilities of the receiving computer system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities... are then determined"); and

logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer system (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be



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used for playback of multimedia streams based on the client machine capabilities”), such that the receiving computer system may use the media message to display the selected one of the plurality of versions of the media content (see col.5, lines 45-46: “media player plays 38 the data as it is received to the user of the client 12”).

Although Sahai teaches of a media message (see col.2, lines 59-60: “multimedia data”) and logic for testing the digital content capabilities of the receiving computer system (see above), Sahai does not explicitly teach of including a first reference and testing when the first reference is given effect.

Hill teaches of a first reference and testing when the first reference is given effect (see col.10, lines 17-26: “The layout generator is executed by the client... interrogates the output device to determine the capabilities of the output device”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Hill to implement a first reference and testing when the first reference is given effect. One would be motivated to do so because Sahai teaches that alternatively a server can send or stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

**DEPENDENT:**

As per **claim 2**, which depends on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic is directly contained in the one or more messages (see col.6, lines 60-63).

As per **claim 3**, which depends on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic is included in the one or more messages by reference (see col.8, lines 45-47).

As per **claim 4**, which depends on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the selected one of the plurality of versions of the digital content is not directly included in the media message as first transmitted to the receiving computer system, but is separately transferred under the control of the logic for displaying (see col.3, lines 15-19).

As per **claim 5**, which depends on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the selected one of the plurality of versions of the digital content is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message (see col.5, lines 41-46).

As per **claim 7**, which depends on claim 6, Sahai further teaches wherein the plurality of different digital content elements includes a high-quality video sequence and a low-quality video sequence (see col.4, lines 25-27).

As per **claim 8**, which depends on claim 6, Sahai further teaches wherein the plurality of different digital content elements includes a video sequence and an animation sequence (implicit: see col.3, lines 57-60 and col.4, lines 25-27).

As per **claim 9**, which depends on claim 6, Sahai further teaches wherein the plurality of different digital content elements includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player (implicit: see col.3, lines 34-40).

As per **claim 10**, which depends on claim 6, Sahai further teaches wherein the selected one of the different digital content elements is selected based upon actions of a user of the computer system in connection with the received message (see col.2, lines 16-18 and col.3, lines 46-49).

As per **claim 40**, which depend on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for testing digital content capabilities of the receiving computer system includes a script to be executed by the receiving computer system to test said digital content capabilities (see col.5, lines 26-31).

As per **claim 41**, which depend on claim 34, Although Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for displaying are appended to the media message (see col.3, lines 15-22), Sahai does not explicitly teach that the logic for testing is also appended.

Hill teaches wherein the logic for testing is appended (see col.10, lines 18-20: "document including an embedded layout generator or script").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Hill so that the logic for testing is appended. One would be motivated to do so because Sahai teaches that alternatively a server can send or stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

9. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai et al. (US 6,594,699 B1) and Hill et al. (US 6,023, 714 A) and further in view of Li et al. (US 6,345,279 B1).

As per **claim 42**, which depend on claim 34, Sahai and Hill do not explicitly teach wherein the instructions, when executed by the processor, generate the one or more messages such that the media message further includes: a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content.

Li teaches of a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content (see col.5, lines 55-62).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai and Hill in view of Li by implementing a replaceable section to be replaced by a replacing section including the selected one of the plurality of versions of media content. One would be motivated to do so because

Sahai teaches that the invention is useful in any client server interactions (see col.7, lines 22-23).

As per **claim 43**, which depend on claim 42, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for displaying includes a replace script (see col.5, lines 26-31) to replace the replaceable section of the media message with the replacing section (see claim 42 rejection above).

### ***Response to Arguments***

10. Applicant's arguments with respect to independent claims have been considered but are moot in view of the new ground(s) of rejection.

With respect to the Declaration filed under 37 C.F.R 1.131, the examiner has cited another reference that teaches the missing limitation of Sahai, specifically "including a first reference" and "testing when the first reference is given effect" (see rejection above).

In response to the argument regarding the 35 U.S.C. 112, 2<sup>nd</sup> rejection with respect to claims 1, 6, and 34, regarding the limitation "when the first reference is given effect", it is noted that the features upon which applicant relies (i.e., "when the first reference is activated to obtain a result associated with the first reference") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant(s) are

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encouraged to amend the language of the claims to particularly point and distinctly claim the subject matter.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, **this is not the mode of claim interpretation to be applied during examination**. During examination, the claims must be interpreted as broadly as their terms reasonably allow. See *In re American Academy of Science Tech Center*, F.3d 2004 WL 1067528 (Fed. Cir. May 13, 2004).

In response to the argument regarding the 35 U.S.C. 112, 2<sup>nd</sup> rejection with respect to claims 1, 6, and 34, regarding the limitation "first reference", the applicant(s) are suggested to remove the term "first". Unless the claims recite a functional limitation of a second reference that is different from the first reference, a numerical antecedence arises.

Nonetheless, the term "first reference" in claims 1, 6, and 34 are rejected under 35 U.S.C 112, 1<sup>st</sup> for failing to comply with the written description requirement.

### ***Conclusion***

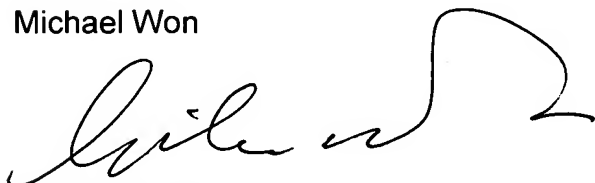
11. For the reasons above claim 1-10, 34, and 40-43 remain rejected and pending.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won

A handwritten signature in black ink, appearing to read 'Michael Won', with a large, stylized flourish at the end.

April 19, 2007